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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/552,162	07/19/2006	Alessandro Esposito	82062-0176	9196
24633 7590 11/20/2007 HOGAN & HARTSON LLP IP GROUP, COLUMBIA SQUARE 555 THIRTEENTH STREET, N.W. WASHINGTON, DC 20004			EXAMINER STORMER, RUSSELL D	
			ART UNIT 3617	PAPER NUMBER
			NOTIFICATION DATE 11/20/2007	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

dcptopatent@hhlaw.com

# Office Action Summary

Application No.

10/552,162

Applicant(s)

ESPOSITO ET AL.

Examiner

Russell D. Stormer

Art Unit

3617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 October 2005 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. ____                                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10/11/05</u>  | 6) <input type="checkbox"/> Other: ____                           |

***Information Disclosure Statement***

The information disclosure statement filed October 11, 2005 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but only the U.S. Patent to Sano has been considered.

The listing of references in the Search Report is not considered to be an information disclosure statement (IDS) complying with 37 CFR 1.98. 37 CFR 1.98(a)(2) requires a legible copy of: (1) each foreign patent; (2) each publication or that portion which caused it to be listed; (3) for each cited pending U.S. application, the application specification including claims, and any drawing of the application, or that portion of the application which caused it to be listed including any claims directed to that portion, unless the cited pending U.S. application is stored in the Image File Wrapper (IFW) system; and (4) all other information, or that portion which caused it to be listed. In addition, each IDS must include a list of all patents, publications, applications, or other information submitted for consideration by the Office. See MPEP § 609.

***Preliminary Amendment***

Applicants' Transmittal Letter states that a substitute specification (item 14) was filed along with the other documents on October 11, 2005. However, the only specification of record appears to be a direct copy of the specification of the priority document, and no document marked "substitute specification" has been received.

### ***Drawings***

The drawings are objected to under 37 CFR 1.83(a) because they fail to show the reference character "46" as described in the specification.

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the wheel having only one spoke as set forth in claim 1, and the bush of claim 14 must be shown or the feature(s) canceled from the claim(s).

**No new matter should be entered.**

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner,

the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The disclosure is objected to because of the following informalities: The spelling of the word "tire" should be corrected throughout the disclosure.

The "bush" described on at least pages 11 and 15 should be provided with a reference character.

Appropriate correction is required.

The disclosure is objected to because the Detailed Description of the Invention does not refer to any of the drawing figures, so as to direct attention to the appropriate figure being discussed. This is especially important when alternate embodiments as described, such as on pages 8, 9, 10, and 11.

Appropriate correction is required.

The disclosure is objected to because the specification does not include headings as required.

Appropriate correction is required.

The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

#### Arrangement of the Specification

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) THE NAMES OF THE PARTIES TO A JOINT RESEARCH AGREEMENT.
- (e) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC.
- (f) BACKGROUND OF THE INVENTION.
  - (1) Field of the Invention.
  - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (g) BRIEF SUMMARY OF THE INVENTION.
- (h) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (i) DETAILED DESCRIPTION OF THE INVENTION.
- (j) CLAIM OR CLAIMS (commencing on a separate sheet).
- (k) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
- (l) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1:

The term "suitable for being associated with a tire" in line 3 is indefinite because the word "associated" does not define any positive relationship between the rim and the tire.

In line 4, the term "suitable for delimiting" is indefinite as it is unclear which part is delimited, what is meant by "delimited," how the rim is "suitable," or how this is accomplished.

In claim 7 the distance of the rim-attachment portion lacks antecedent basis.

In claim 13, the phrase "outside a projection" is indefinite as the word "outside" is undefined, the projection is inferentially claimed, and there is no explanation of how the duct is positioned outside. Further, the "central plane" lacks antecedent basis, and it is not clear if the projection or the plane is part of the brake disc.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3-6, 8, 10, 12, 13, and 17-23 are rejected under 35 U.S.C. 102(b) as being anticipated by Hurrell, II (hereafter "Hurrell")

Hurrell discloses a wheel having a first duct 50 and a second duct 40 having a raised portion and a valve 52 fitted in the second duct.

The wheel is described as a conventional cast wheel 32, made of a suitable alloy which would inherently include aluminum and magnesium. The wheel is described as a disc-type wheel having a web 44, and spokes are not shown, but modern cast wheels of this type invariably include openings in the disc to allow the brakes to be cooled by airflow through the discs. Openings would therefore be inherent in this wheel, and the openings would form spokes extending between the rim and the hub.

A flattened surface within the second duct abuts the valve 52 and sealing means 62.

With respect to claim 10 the first duct 50 is considered to extend substantially radially.

With respect to claim 13, the second duct is positioned outside a projection onto the brake.

With respect to claims 21-23, the method of manufacturing the wheel and valve assembly is given no patentable weight inasmuch as method claims 21-23 depend from a product claim.



***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 7, 9, 11, 14, 15, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hurrell.

With respect to claim 7, the first and second ducts of Hurrell do not extend for a distance shorter than (length or width of?) the rim attachment portion, but this would be a function of the size and width of the wheel, and to design the wheel such that the first and second ducts did extend a shorter distance than the rim attachment portion would have been obvious based on the size of the wheel and the rim, and the positioning of the second duct in the spoke.

With respect to claim 9, Hurrell does not show a threaded coupling between the second duct and the valve body, but to provide the internal wall of the second duct with threads, and to provide the valve body with corresponding threads would have been obvious to those of ordinary skill in the art to better retain the valve in the second duct and prevent unintentional removal of the valve body. Further, providing the second duct and the valve body with corresponding threads would yield a predictable result.

With respect to claim 11, the first duct does not extend substantially symmetrical relative to the central plane of the wheel, but this would be a function of the design of the wheel, and to form the spokes in a substantially radial extent such that the first duct therein extended substantially symmetrically to the central plane would have been obvious in order to achieve a desired design or effect in the wheel structure.

With respect to claims 14-16, Hurrell does not disclose the use of a bush housed in the second duct. The use of bushings to mount elements in openings is well-known and to use a bush in the second duct of Hurrell to receive the valve body would have been obvious to those of ordinary skill in the art as a mechanical expedient which would allow the fitting of different sizes of valve bodies in the spoke, or would allow the valve body to be better positioned in the second duct.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hurrell in view of Hinman et al.

The wheel of Hurrell is not formed such that a central plane will divide the wheel into two symmetrical half portions.

Hinman et al teaches a cast wheel comprising a rim, spokes, and a hub and being arranged such that a central plane will divide the wheel into two symmetrical halves. See figure 2.

From the teaching to would have been obvious to form the wheel of Hurrell to be symmetrical about a central plane so that the wheel could be used on a motor cycle or other two-wheeled vehicle. Note that Hurrell discloses that the wheel is a conventional wheel, and the invention is in the first and second air ducts. To apply the air ducts to another type or form of conventional wheel would have been obvious to those of ordinary skill in the art, and forming the wheel of Hurrell to be symmetrical about a central plane and having the first and second ducts would produce predictable results.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The references show other cast or spoked wheels, and other tire inflating arrangements.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Russell D. Stormer whose telephone number is (571) 272-6687. The examiner can normally be reached on Monday through Friday, 9 AM to 4 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Morano can be reached on (571) 272-6684. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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11/7/07

  
RUSSELL D. STORMER  
PRIMARY EXAMINER 11/7/07